

Appl. No.: 09/883,990
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REMARKS

Claims 1-6 are pending in this application. Claim 1 is the only independent claim. By this amendment, claims 1 and 2 are amended for clarity.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Personal Interview

Applicant wishes to thank Examiners John Villecco and Wendy Garber for the courtesies extended to Applicant's representative, Carolyn Baumgardner, during the February 8, 2005 personal interview.

During the interview, the differences between the claimed invention and the Hosoya reference were discussed. The substance of the personal interview is summarized in the following remarks.

Allowable Subject Matter

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in dependent claims 5 and 6 over the art of record. The Office Action also indicates that claims 5 and 6 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, applicant respectfully submits that all of claims 1-6 are allowable, for at least the reasons set forth below.

The Claims Define Patentable Subject Matter

The Office Action makes the following rejections:

(1) claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 06-283999 A to Hosoya et al. (hereafter Hosoya);

(2) claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoya; and

(3) claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoya in view of U.S. Publication No. 2001/0047127 A1 to New, Jr., et al. (hereafter New).

These rejections are respectfully traversed.

Applicant respectfully submits that Hosoya, either alone or in combination with New, fails to teach or suggest each and every feature as set forth in the claimed invention.

The Examiner alleges that Hosoya discloses a semiconductor integrated circuit for reducing the noise between an analog circuit and a digital circuit. (see Office Action, page 2, paragraph 5). In essence, the Examiner believes that Hosoya discloses an analog circuit (14) operating in response to a first clock (CLK2), a digital circuit (12) operating in response to second clock (CLK2), a plurality of phase shift circuit (D1-D4) for shifting the phase of the second clock signal (CLK1) from the phase of the first clock signal (CLK2) by a different value, and a spectrum analyzer (30) for measuring the noise generated by the analog circuit (14). (see Office Action, paragraph 5).

However, according to the present specification, Hosoya, only in an experimental stage, connects a sine-wave generator and a spectrum analyzer to its semiconductor integrated circuit device in conjunction with a clock phase difference generating circuit for producing the least noise in the analog circuit. Thereafter, in the mass production stage, in Hosoya, the sine-wave generator and the spectrum analyzer are removed. As a result, only one mask in Hosoya is changed out of all of the mask configurations provided in the experimental stage. (see present specification, paragraph [0008])

In other words, during manufacturing (mass production) Hosoya provides a fixed wiring pattern for the previously selected clock phase difference. That is, once a clock phase difference is selected in the experimental stage, Hosoya's wiring pattern is fixed so that only this clock phase difference generating circuit is activated in the mass production manufacturing stage.

As such, Hosoya's previously selected clock phase during the experimental stage fails to take into consideration the variations in transistor characteristics, resistance or the like that occurs during the manufacturing stage. As a result, the present application is distinguishable from Hosoya because in the present invention variations in transistor characteristics, resistance and the like during the manufacturing stage are taken into consideration when selecting the clock phase because, unlike in

Hosoya, the selection of the clock phase occurs during the manufacturing stage.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsisssimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Hosoya, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 1 and dependent claim 2 are allowable over Hosoya for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §102(b) is respectfully solicited.

Applicants also respectfully submit that New fails to make up for the deficiencies found in Hosoya.

Specifically, like Hosoya, New also fails to take into consideration the variations in transistor characteristics, resistance and the like.

Applicant respectfully submits that neither Hosoya nor New, taken singularly or in combination, (assuming these teachings may be combined, which applicant do not admit) teach or suggest each and every feature as set forth in the present invention.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicants respectfully submit that not only does the references fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in

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the art would not have been motivated to combine/modify the teachings of Hosoya with New because there is no teaching or suggestion in any of the references regarding how or why one would modify such systems to arrive at the claimed invention.

Applicants respectfully submit that dependent claims 3 and 4 are allowable over Hosoya, either alone or in combination with New, for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

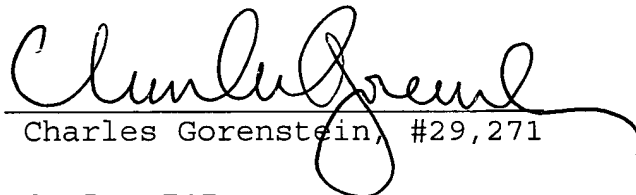
Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for two (2) months extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
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